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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/492,844
Filing Date: January 27, 2000
Appellant(s): RONNING ET AL.

MAILED

NOV 23 2007

GROUP 3600

Shawn B. Dempster
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/22/2007 appealing from the Office action mailed 10/03/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct. This summary is directed to only independent claims 1 and 23 and the language and limitations of claim 23 are similar except that they recite a system performing the method recited in claim1.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,226,618	DOWNS	5-2001
5,652,786	ROGERS	7-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims, as reproduced from the Final office action mailed on 10/03/2006:

Quote: "

Response to Arguments

2.1. Objection to **Priority claim**: The applicant's arguments, see Remarks, pages 6-8, and the interview summary mailed on 9/28/2006, have been fully considered and found persuasive and therefore, the Objection to the Priority claim presented in the earlier Office action mailed on 6/29/2005, is withdrawn.

2.2 Applicant's arguments filed on 12/29/2005, see Remarks on pages 8-11, concerning rejection of claims 1, 3, 8, 14-16, 23, 25, 30, 36-38 and 67-68 under 35 USC 103 (a) as being unpatentable over Downs in view of Rogers (US Patent 5,652,786) have been fully considered but not found persuasive for following reasons:

The applicant argues, see page 9, lines 1-15, that the cite reference Rogers is a nonanalogous art. The examiner respectfully disagrees. In response to applicant's argument that Rogers is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the applicant faces the problem that if a illegitimate user tries to access the server using a

file identifier to conduct a commercial online transaction, such as downloading content by using several attempts to verify himself then how to automatically prevent the downloading action after a permitted number of attempts. In the analogous art, Rogers faced the same problem of stopping fraudulent activities such as, accessing an account online by making illegitimate unlimited fishing attempts to access the account and arrived at a solution of stopping the user's online activity if he is not able to input and verify the correct identifier, that is the access code within three attempted trials. Roger's solution is similar to the solution the applicant provides in his invention and independent claims, that is allowing a number of attempts, such as three in Rogers, for verify the file/order identifiers to enable the commercial transaction of downloading a file.

The applicant argues that Rogers's reference is non-enabling because it does not teach downloading of anything. The examiner respectfully disagrees because the applicant is attacking the Roger's reference individually when the rejection is made under 35 USC 103 (a) in view of the combined teachings of Downs and Rogers. Downloading of files is taught by Downs'618, but Downs did not teach the limitation of allowing the online commercial transaction of downloading based upon a number of permitted attempts in verifying the file/order identifier Roger's analogous teachings of limiting the access to an online account for conducting an online transaction based upon a maximum of three attempts to provide the right access code. The concept of limiting the access to an online account for conducting an online transaction based upon a number attempts to provide a verifiable identifier [which is a valid access code in Rogers or valid file and order identifiers in the claimed application] can be used in any online transaction, irrespective of the nature of online transaction, that is bill payment in Rogers or downloading content in the claimed application. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant further argues (see Remarks, pages 10-11), that there is no suggestion to combine the arts of Downs and Rogers and hence Examiner has failed to establish a prima facie case of obviousness. The examiner respectfully disagrees. In response to applicant's argument that there is no suggestion or motivation to combine the teachings of Downs and Rogers, the test for obviousness is not whether the features of a secondary reference, that is the teachings of Rogers may be bodily incorporated into the structure of the primary [Downs] reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the present case, it would be obvious to one of an ordinary skilled in the art that when the teachings of downloading a content, in Downs, are combined with the Roger's teachings of limiting the access to an online account for conducting an online transaction based upon a number attempts to provide a valid access code would result in permitting the downloading of content based upon a limited number of the user's attempts to enter the correct verifiable identifier. Doing so would help to stop the online transaction of downloading, which is expected to follow after providing the correct access code/identifiers, to avoid possible fraudulent activity by illegitimate persons who are on a fishing expedition to access online accounts.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the present case, it would be obvious to one of an ordinary skilled in the art that when the teachings of downloading a content, in Downs, are combined with the Roger's teachings of limiting the access to an online account for conducting an online transaction based upon a number attempts to provide a valid access code would result in permitting the downloading of content based upon a limited number of the user's attempts to

enter the correct verifiable identifier. Doing so would help to stop the online transaction of downloading, which is expected to follow after providing the correct access code/identifiers, to avoid possible fraudulent activity by illegitimate persons who are on a fishing expedition to access online accounts. The examiner has taken into account only knowledge from the prior arts of Downs and Rogers and within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would be obvious to one of an ordinary skilled in the art that when the teachings of downloading a content, in Downs, are combined with the Roger's teachings of limiting the access to an online account for conducting an online transaction based upon a number attempts to provide a valid access code would result in permitting the downloading of content based upon a limited number of the user's attempts to enter the correct verifiable identifier. Doing so would help to stop the online transaction of downloading, which is expected to follow after providing the correct access code/identifiers, to avoid possible fraudulent activity by illegitimate persons who are on a fishing expedition to access online accounts.

In view of the foregoing, the rejection of claims 1, 3, 8, 14-16, 23, 25, 30, 36-38 and 67-68 rejected under 35 U.S.C. 103(a) as being unpatentable over Downs and Rogers is sustainable as presented in the earlier Office action mailed on 6/29/2005 and is reproduced again below. This is a Final rejection..

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.1. Claims 1, 3, 8, 14-16, 23, 25, 30, 36-38 and 67-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs and further in view of Rogers (US Patent 5,652,786), hereinafter, referred to Rogers.

Regarding claims 1, 3, 8, 16, and 67, Downs teaches a method performed by an electronic commerce system having a server and an end user machine interacting through a network for secure downloading of a file from the network, the method comprising steps of:

receiving a selection of a file via the network, receiving an order from a user, during an online session, for download of the selected file, the order including a file identifier related to the file and an order identifier related to the order, verifying the file identifier based upon particular information related to the file comprising one or more of the following: verifying a version identifier related to the file, a uniform resource locator for the file; or verifying the order identifier based upon particular information related to the order comprising a custom identifier associated with the user, verifying a transaction identifier associated with the order, and the particular information related to the order including: determining if the order identifier is valid for the order, meaning the order identifier exists for the order, determining if the order identifier is active, meaning the order was not canceled before the download of the file, and determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file, during the online

session, and selectively permitting the download of the file based upon a number of requested downloads based upon the verification of the file identifier, transaction identifier and the order identifier, receiving a selection of a uniform resource locator for the file and determining if the uniform resource locator is valid, active, non-suppressed or charged, also selectively downloading the file based upon a number of successful downloads of the file and upon a time parameter related to submission of the order, and denying the download based upon a customer identifier associated with the user (at least see, col.3, lines 40-55, *...transferring the encrypted data...clearing house...transferring the re-encrypted data...to the user's system...*". col.7, lines 2-16, *...licensing authorization and control...conditions of purchase and license, such as permitted number of copies, number of plays, and the time interval or term the license may be valid ...enabling intermediate or End-User (s) to unlock content after verification of a successful completion of licensing transaction..*", col.8, lines 26-31, *...The architecture is open...Distribution of audio, programs, multimedia, video or other types of Content...*", col.10, lines 19-26, *...Once an Electronic Digital Content Store(s) 103 completes a valid request for Electronic Content 113 from an End-User(s)....The Electronic Digital Content Stores (s) also authorizes the download of the SC containing the Content 113 "*, col.11, lines 30-54, *...The End-User Device(s) 109 can be any player device.....The End-User device (s) 109 manages the download and storage of SCs containing the Digital Content.....the use or running-on an End-User device(s) "*, col.24, lines 17-47, *...Upon reception of the Order SC9s) 650 from the End-User Devices (09), the Clearinghouse (s) 105 verifies:2. that the order SC (s) 650 has not been altered.....Transaction Data 642 and Symmetric Key 623 are complete and authentic.....If the verifications are successful.....transfers the License SC (s) 660 to the End-User Device (s) 109...."*, col.26, lines 24-58, *...When an End-User Devices (109 receives the Content.....Instead, the SC (s) includes an external URL.....to point to the Content 113.....Electronic Digital Content Store (s) 103 also.....extracting metadata information from them to build HTML pages.....present descriptions of Content 113 to End-User (s), usually so they can purchase the Content 113 "*, col.27, lines 6-21, *...The End-User device (s) 109 receives the Transaction SC (s) 640 and validates the integrity of the Transaction SC (s) 640 and the included Offer SC (s) 641.....The Clearinghouse (s) 105 validates and processes Order SC (s) 650...access purchase Content 113 "*, col.28, lines 30-50, *...Each record includesa URL that points to another SC (s) that includes the encrypted part..."*, col.29 line 18-col.30, line 62, *...[Content URL]....Content ID- A part that defines a unique ID assigned to a Content 113 item....SC Version-A version number assigned to the SC (s)...SC ID--"*, col.33, line 25-col.34, line 50, *...Transaction ID 535...End-User (s) ID--Verify the Digital Signature 643 of the SC (s).....Verify the integrity and authenticity of each Offer SC (s) 641 included in the Transaction SC (s) 640..."*, col.40, line 35-col.41, line 4, *...The ID property is a unique value ...T property specifies the type of the SC (s)...A property identifies the author or publisher....D property identifies the date...E property identifies the date, and optionally, the time that the SC (s) expires...CCURL value...CCURL property identifies the URL of the Clearinghouse (s) 105. The value should be the form of a valid external URL..."*, col.44, lines 5-42, *...Validation....The Clearinghouse(s) 105 begins the validation of Order SC 9s) 650 by verifying the digital signatures.....integrity of the Order SC (s) 650 parts....The process of verification of the Transaction and the Offer SC (S)Then, the Storage Usage Conditions 519 of the Content 113...are validated by the Clearinghouse (s) 105....."*, col.45, lines 15-28, *...In all the processing of the Order SC (s) 650 is successful...If the Clearinghouse (s) 105 is not able to successfully process the order SC (s) 650.....The HTML page indicates the reason that the Clearinghouse (s) 105 was unable to process the transaction "*, col.46, lines 5-61, col.50, line 34-col.51, line 39, col.54, lines 55-64, col.59, line 7-col.60, line 13, col.72, lines 11-59, col.75, line 1-col.77, line 23, col.79, line 10-col.89, line 20.). Downs further teaches determining if an order identifier is also active-corresponding order must not have been canceled before downloading the ordered file, and non-suppressed -order must not have been canceled after downloading the ordered file, (see Downs at least col.10, line 50-col.11, line 27, wherein Downs teaches that the Clearinghouse (s) 105 checks all transactions relating to sale before authorizing license and later checks if the user is permitted to use the authorized license and this corresponds to checking if the order is canceled before and after the order. Also see at

least col.6, line 65-col.8, line 5, col.10, lines 19-48, col.81, line 10-col.82, line 22, col.85, lines 53-63.).

Downs does not teach permitting download of the file to the end user machine based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user. However, in the analogous field of endeavor, that is method and apparatus of bill payment via a network to prevent fraudulent transactions, Rogers discloses permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user (see at least col. 6, line 33-col. 9, line 17, wherein Rogers teaches that while users conducting bill payments via a network (telephone), the users are allowed certain number of attempts to validate the entry of access codes, account numbers, debit card numbers, dollar amount and if the attempted downloads of the file, that is entering the numbers of access codes, account numbers, debit card numbers, and dollar amount exceed certain numbers a corresponding action is initiated. If the attempts to download the file including the various information relating to numbers, as cited above, are within three attempts the user is allowed to continue the download of the files including that information but if the attempted downloads exceed 3 the transaction is stopped for further validation. Rogers teachings of permitting downloading of files containing access codes, account numbers, debit card numbers, dollar amount based upon the number of attempted downloads, that is three and if the third is successful then the transaction is continued and if unsuccessful then the transaction is discontinued is reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In view of Rogers, it would have been obvious to one of an ordinary skill in the art at the time of the invention to have modified Downs to incorporate the feature of permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user. Doing so helps the Downs system to prevent fraudulent use of debit cards for payments, as explicitly suggested Rogers.

3.2. With regards to claims 14-15, the steps of requesting identification of a file name for storing the file, displaying a default identification as the file name for storing the file based upon an identification of the file and transmitting the generated file identifier for display to the user are inherent during the download.

3.3. With regards to apparatus claims 23, 25, 30, 36-38, and 68, their limitations correspond to method claims 1, 3, 8, 14-16, 67 and are, therefore, analyzed and rejected similarly. "

Unquote.

(10) Response to Argument

With regards to independent claims 1 and 23, the Appellant argues that Downs does not teach (see at least page 6, line 24-page 7, line 22),

*" What Downs '618 fails to teach, describe, or even suggest is selectively permitting download of the file to the end user machine based upon the verification of the order identifier and a number of attempted downloads of the file by the user, as described in the language of the pending independent claims 1 and 23. **As contemplated by the present claims of the invention, downloading of a file is predicated on determining at the time of downloading the file whether an order identifier is authentic**Thus Downs'618 is incapable of and does not suggest verification of the order identifier prior to permitting download a file."*

The Examiner respectfully disagrees. Downs does teach selectively permitting download of the file to the end user machine based upon the verification of the order identifier. Down's method and system are directed to secured distributing and downloading of digital files, including printed media, films, games and music over Internet from a electronic hosting site/store to a user's machine/system with proper authorization and validation using a Clearhousing system (see at least col.1, lines 50-57, col.3, lines 41-56, col.7, lines 11-65, Figs. 1A-1C, col.18, line 5-col.19, line 34 disclosing steps 135-148 and col.45, line 45-col.46, line 61). An exemplary process flow is illustrated in fig.1:

The End-user uses a device 109 to surf web sites and while surfing the web site 111 finds a music file, which he wants to buy [the music file has identifiers such as E.G. UPC, ISRC, ISMN or equivalent, see Fig.12, 1201. See

also col.29, lines 31-34, col.72, lines 35-48 which teach that the contents/products purchased have a unique Content ID/product ID assigned to the purchased content], the purchase request is submitted to an Electronic digital Content Store 103. The electronic Digital Content Store103, after receiving credit card authorization number from a credit card clearing organization, invokes the SC Packer Tool to build a Transaction SC [secure container]. This Transaction SC includes the Offer SCs for the Content 113 that the End-User(s) has purchased, a Transaction ID that can be tracked back to the Electronic Digital Content Store(s) 103, information that identifies the End-User(s), Usage Conditions, price list for the songs purchased, etc.. This Transaction SC is then transmitted to the End-User Device(s) 109. Based on the time the End-User(s) wants the download, the end-User Player Application 195 initiates the start of the download process by building a Order SC that contains among other things the Encrypted symmetric Key for the Content 113, the Transaction ID, and End-User(s) information. This Order SC is then sent to the Clearinghouse(s) 105 for processing. The Clearinghouse(s) 105 receives the Order SC, opens it and verifies that none of the data has been tampered with. The Clearinghouse(s) 105 validates the Usage Conditions purchased by the End-User(s). These Usage Conditions must comply with those specified by the Content Provider(s) 101. Once all the checks are complete [**Note: see col.45, line 45-col.46, line 61. Clearinghouse 105 audits, verifies ,tracks ,logs and authenticates the Transaction ID, Content ID, End-user's Device at the time of the End-user's request for License SC**

660 and when the Clearinghouse 105 sends the License SC 660 after verification and checks to the End-user's device 109 to enable and implement the download of music file by the End user's device] , the

Encrypted symmetric Key is decrypted using the private key of the Clearinghouse(s) 105. The symmetric Key is then encrypted using the public key of the End-User(s). This new Encrypted symmetric Key is then packaged into a License SC by the SC Packer and the License SC is then transmitted to the End-User(s). When the License SC is received at the End-User Device(s) 109 it is stored in memory until the Content SC is downloaded. From the above process in Downs, it can be summarized that after the user places an order for downloading a music file a Transaction SC is built containing all the details about the content to downloaded, the transaction details, that is order details and transaction ID, the usage conditions and is sent to both the user machine 109 and the Clearinghouse 105. Only upon verification of content details [which includes content identifier and description], the transaction ID [order identifier] , end-user details, usage conditions the Clearinghouse builds a License SC and sends it to the user machine 109 and only after receipt of this License SC selectively permits the end user device to download the purchased music file to be used as per the usage conditions already agreed.

In view of the foregoing, it is clear that Downs teaches **downloading of a music file to a user's machine only after verifying certain parameters, such as transaction ID [corresponds to order identifier] , end-user device, and usage conditions agreed as per the purchase order.**

The Appellant argues (see page 7, line 23-page 8, line 4), that Downs does not teach verifying a number of attempted downloads of the file and states, *"For Downs '618 to check whether the user has exceed a threshold on number of attempts to download the same file, Downs '618 would have to have some way of uniquely identifying an end user device 109 and request 607 so that a count of download attempts could be kept. Downs '618 never describes receiving anything that could uniquely identify an end user device 109. Furthermore, Downs '618 does not describe any facility for storing information about download transactions so that they can be compared to future download requests from an end user device. As such, Downs '618 fails to describe the feature presently claimed in claims 1 and 23 of times downloading.....".* The Examiner disagrees.

In response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e., *uniquely identifying an end user device 109 and request 607 so that a count of download attempts could be kept and facility for storing information about download transactions so that they can be compared to future download requests from an end user device.*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, the Examiner would like to point out that Downs does teach *uniquely identifying an end user device 109 and request 607 so that a count of download attempts could be kept and facility for storing information about download transactions so that they can be compared to future download requests from an end user device*, see at least col.70, lines 4-13. Also see col.45, line 45-col.46, line 61. Clearinghouse 105 audits, verifies

,tracks ,logs and authenticates the Transaction ID, Content ID, End-user's ID at the time of the End-user's request for License SC 660 and when the Clearinghouse 105 sends the License SC 660 after verification and checks to the End-user's device 109 to enable and implement the download of music file by the End user's device.).

In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the Examiner has used the combination of teachings from two references Downs and Rogers and therefore one cannot show nonobviousness by attacking Downs's reference individually. Downs does not explicitly teach detecting and verifying a number of attempts for the intended transaction of downloading of a file by the user (as already acknowledged by the Examiner in the Final office action on page 11) and therefore Examiner used Rogers disclosure (see at least col.6, line 33-col.9, line 17; Fig. 2A,2B,2C,2D) of analogous teaching in the system and method of making bill payments via a communication network that is of detecting and verifying the number of attempts made to enter access code/debit card number/account number or frequency of attempts to make payments and if these attempts exceed a predetermined number say three attempts then the user is stopped from carrying out the intended transaction to prevent a potential fraud.

The Appellant further argues (see page 8, line 29-page 10, line 13) that Roger's art is neither in the field of the Appellant's endeavor nor reasonably pertinent to the particular problem with which the Appellant was concerned. The Examiner respectfully disagrees.

Note: As per the MPEP 2111 guidelines, the pending claims must be given the " broadest reasonable interpretation consistent with the specification". Accordingly, the Examiner interpreted the limitation, " selectively permitting the download of file based upon a number of attempted downloads of the file by the user" as to stop the user 's intended transaction if his number of attempts to access the files to be downloaded exceeds a predetermined number, say three as disclosed in Rogers, to prevent a potential fraud and if the number of attempts are less than the predetermined number, say three, then allow the user to continue with the intended transaction. Number of attempts could be for either entering a wrong access code/debit card number/account number or exceeding the frequency of payments as disclosed in Rogers or for transaction of a download of a music file in Downs or the applicant's invention and when those attempts exceed a predetermined number and are detected by the system then the system stops the user's intended transaction, which could be as paying a bill in Rogers or intended download of a music file in Downs or in the applicant's invention. The reason for doing this check and verification in Rogers is to stop a potential fraud from happening, which is similar to the Appellant's intended use of verifying the attempted downloads (see Appellant's specification, page 25, lines 8-21, and page 27, lines 4-7) . Downs teaches (see col.7, lines 34-55, col.20,

lines 6-50 and col.70, lines 4-13) that the Clearinghouse will not permit unauthorized requests or requests that do not comply with the usage conditions, such as checking the use restrictions, that is restricting the number of downloads/copies of a file, say music file. But, as stated above, Downs does not explicitly teach verifying a [predetermined] number of attempts to carry out transaction, that is for download the music file. In view of Rogers, it would be obvious to one of an ordinary skilled in the art to incorporate this technique of detecting and verifying number of attempts made by a user in carrying out a transaction via a communication network because as suggested in Downs [see at least col.70, lines 4-13, col.7, lines 34-55, col.20, lines 6-50] it would enhance prevention of fraud by preventing the user's intended transaction of downloading a music file or his attempts to enter a right code to access the downloading of file beyond a agreed number of attempts already agreed and indicated in the usage conditions format or if the frequency of downloads does not match with the predetermined usage conditions 517.

The Appellant argues (see page 10, line 14-page 11, line 16) that combination of the teachings of Downs and Rogers does not satisfy the conditions laid out in KSR International v. Teleflex Inc. court case. The Examiner disagrees because, as analyzed above, combination of the teachings of Downs and Rogers meet the (TSM) test that is the prior art in Downs [see at least col.70, lines 4-13, col.7, lines 34-55, col.20, lines 6-50] and Rogers (see at least col.6, line 33-col.9, line 17) both provide the teaching, suggestion, or motivation to

verify the user's number attempts before allowing the user to carry on with his intended transaction [which could be any type, that is of bill payment, as in Rogers, or a download of music file, as in Downs) to prevent a potential fraud by using an incorrect access code or exceeding the frequency of payments or frequency of music downloads. If the combination of teachings of Downs and Rogers satisfies the (TSM) test then it obviously satisfies the Court's analysis in KSR International v. Teleflex Inc because according to Supreme Court the TSM test is one of a number of valid rationales that could be used to determine obviousness. In keeping in line with KSR case, all the claimed elements were known in the prior art, as analyzed above, and one skilled in the art could have combined the features as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of an ordinary skilled in the art at the time of the invention.

The Appellant alleges the use of improper hindsight (see page 11, lines 9-16) in combining the teachings of Downs and Rogers to arrive at the claimed invention. In response to Appellant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*,

443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the Examiner has used the knowledge from the prior art teachings of Downs and Rogers only to teach the Appellant's invention recited in claims 1 and 23 and has not gleaned any teachings from the Appellant's disclosure.

The Appellant has made conclusive statements stating that Downs fails to teach the limitations of dependent claims 3, 8, 16, 25, 30, 38, 67 and 68 (see page 8, lines 5-19). It is to be noted that the Appellant has not provided Summary of claimed subject matter of each dependent claim, if argued separately, as set forth in 37 CFR 41.37 (c) (1) (v).

Downs does teach the limitations of claims 3 and 25, that is verifying the file identifier step includes verifying one or more of the following: a version identifier related to the file; a uniform resource locator for the file; or a customer identifier associated with the user (see at least Downs col.29, lines 18-45, col.33, lines 25-42 which disclose that the SC [secure container 640 which is prepared after receiving an order from a user for buying download of music file, col.19, lines 1-34, steps 138] includes unique content ID that is to be downloaded, URL information which points to the encrypted metadata, a transaction ID, End-user's ID, etc. Also refer to col. 72, lines 35-48 and col.73, line 54-col.74, line 7. Also see col.45, line 45-col.46, line 61. Clearinghouse 105 audits, verifies ,tracks ,logs and authenticates the Transaction ID, Content ID, **End-user's Device** at the time of the End-user's request for License SC 660 and when the Clearinghouse 105 sends the License SC 660 after verification and

checks to the End-user's device 109 to enable and implement the download of music file by the End user's device).

Downs does teach the limitations of claims 8 and 30, that is verifying a transaction identifier associated with the order, and wherein the permitting step further includes download of file based upon verification of the transaction identifier (see at least col.45, line 45-col.46, line 61. Clearinghouse 105 audits, verifies ,tracks ,logs and authenticates the **Transaction ID**, Content ID, End-user's device at the time of the End-user's request for License SC 660 and when the Clearinghouse 105 sends the License SC 660 after verification and checks to the End-user's device 109 to enable and implement the download of music file by the End user's device).

Downs does teach the limitations of claims 16 and 38, that is denying the download of the file based a custom identifier associated with the user (col.33, lines 25-37 disclose that SC 640 includes a Transaction ID, End-User's ID, End-User's Public Key and they are all verified by the clearing house 105 before permitting the download of a music file ordered by the user, see col.19, lines 1-34 disclosing steps 137-148. Also see col.45, line 45-col.46, line 61.

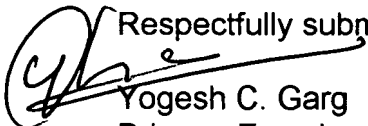
Clearinghouse 105 audits, verifies ,tracks ,logs and authenticates the Transaction ID, Content ID, **End-user's Device** at the time of the End-user's request for License SC 660 and when the Clearinghouse 105 sends the License SC 660 after verification and checks to the End-user's device 109 to enable and implement the download of music file by the End user's device) .

Downs does teach the limitations of claims 67 and 68, that is permitting down load of the file based upon a number of successful downloads of the file by the user. It has already been analyzed above that Downs in view of Rogers permit downloading of ordered music files based upon verifying a number of attempted downloads. Downs (see col.70, lines 4-13, col.7, lines 40-55, col.20, lines 6-50) teaches determining and verifying from the usage conditions the number of allowed copies/recordings to other external devices and downloads of purchased music files are permitted and after the expiration of approved number of copies/recordings to other external devices and downloads restrict further use.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

 Respectfully submitted,
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